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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,791	10/22/2003	Alan R. Hirsch	TAD-32179	5622

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EXAMINER	
FLOOD, MICHELE C	
ART UNIT	**PAPER NUMBER**
1655	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,791	HIRSCH, ALAN R.	
	Examiner	Art Unit	
	Michele Flood	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 March 2005*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,26,27 and 31-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-11,26,27 and 31-40* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I, Claims 1-11, 26 and 27, in the reply filed on March 1, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Acknowledgment is made of Applicant's cancellation of Claims 12-18, 20, 21 and 28-30, and the addition of newly added Claims 31-40.

Further view of the claims deems a restriction requirement is necessary, as set forth below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4 and 26, drawn to a method of modifying perception of body weight comprising the step of administering to a person for inhalation an effective amount of a composition comprising a hedonically positive mixture of a floral odorant and a spice odorant in effective amounts such that the person perceives the body weight to be about 5-10% less than actual body weight, classified in class 424, subclass 725 or class 514 or class 514, subclass 909, for example.

II. Claim 5, drawn to a method of modifying perception of body weight comprising the step of administering to a person for inhalation an effective amount of a composition comprising a suprathreshold but not-irritant

concentration of a hedonically positive mixture of a floral odorant and a spice odorant in effective amounts such that the person perceives the body weight to be about 5-10% less than actual body weight, classified in class 424, subclass 725 or class 514 or class 514, subclass 909, for example.

III. Claim 6, drawn to a method of altering a person's perception of their body weight comprising the step of administering a composition comprising a suprathreshold but not-irritant concentration of a hedonically positive mixture of a floral odorant and a spice odorant to the person for inhalation such that the person perceives their body weight to be less than their actual body weight, classified in class 424, subclass 725 or class 514 or class 514, subclass 909, for example.

IV. Claims 7 and 31-33, drawn to a method of altering a person's perception of body weight comprising the step of administering for inhalation an effective amount of a composition comprising a suprathreshold but not-irritant concentration of a hedonically positive mixture of a floral odorant and a spice odorant such that the person perceives the body weight to be less than the actual body weight, classified in class 424, subclass 725 or class 514 or class 514, subclass 909, for example.

V. Claims 8-11, drawn to a method of altering perception of body weight comprising the step of administering a composition comprising a suprathreshold bout non-irritant concentration of a hedonically positive

mixture of effective amounts of a floral odorant and a spice odorant to a first person for inhalation such that the first person perceives the body weight of a second person to be less than the actual body weight of the second person, classified in class 424, subclass 725 or class 514 or class 514, subclass 909, for example.

VI. Claim 27, drawn to a method of altering perception of body weight comprising the step of administering a composition comprising a suprathreshold but non-irritant concentration of a hedonically positive mixture of effective amounts of a floral odorant and a spice odorant to a first person for inhalation such that the first person perceives the body weight of a second person to be less than the actual body weight of the second person, wherein the floral odorant is selected from a recited Markush group and wherein the spice odorant is selected from a recited Markush group, classified in class 424, subclass 725 or class 514 or class 514, subclass 909, for example.

VII. Claims 34 and 35, drawn to a method of altering perception of body weight comprising the steps of testing olfactory ability of a person; and administering to the person for inhalation an effective amount of a composition comprising a suprathreshold but non-irritant concentration of a hedonically positive odorant mixture consisting essentially of effective amounts of a floral odorant and a spice odorant such that the person perceives their body weight or the body weight of another individual to be

less than the actual body weight, classified in class 424, subclass 725 or class 514 or class 514, subclass 909, for example.

VIII. Claims 36-38, drawn to a method of altering perception of body weight comprising the steps of testing olfactory threshold of a person; and administering to the person for inhalation an effective amount of a composition comprising a suprathreshold but non-irritant concentration of a hedonically positive odorant mixture consisting essentially of effective amounts of a floral odorant and a spice odorant such that the person perceives their body weight or the body weight of another individual to be less than the actual body weight, classified in class 424, subclass 725 or class 514 or class 514, subclass 909, for example.

IX. Claim 39, drawn to a method of altering perception of body weight comprising the steps of sequentially administering to a person for inhalation of a plurality of odorant mixtures, each of said odorant mixtures consisting essentially of a floral odorant and a spice odorant; asking the person to identify each of said odorant mixtures as either hedonically positive or hedonically negative; and administering an effective amount o a composition comprising a suprathreshold but non-irritant concentration of the hedonically positive odorant mixture such that the person perceives their body weight or the body weight of another individual to be less than the actual body weight, classified in class 424, subclass 725 or class 514 or class 514, subclass 909, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the nine different inventions are directed to nine methods encompassing different experimental parameters, different process steps, different concentrations of a mixture of ingredients, wherein the ingredients are not necessarily the same; and, thereby provide different functional effects as evidenced by the claims themselves. These methods are independent since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method alone.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species: the different floral odorants and spice odorants of Claim 27 and Claim 40. The species are independent or distinct because the claim-designated ingredients are characterized by divergently different botanicals having divergently different biological and/or biochemical functions. Thus, if Applicant elects either Group VI or Group IX set forth above, Applicant is **also** required under 35 U.S.C. 121 to elect a **single** disclosed species of composition containing **one** floral odorant and **one** spice odorant,

specifically stating the odorants of said one compound, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

This application also contains claims directed to the following patentably distinct species: the different disease conditions of Claims 31-33. The species are independent or distinct because the claim-designated disease conditions are characterized by divergently different clinical manifestations and/or divergently different physiological, psychological and biological pathologies. Thus, if Applicant elects Group VI set forth above, applicant is **also** required under 35 U.S.C. 121 to elect a **single** disclosed species of disease condition, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

This application contains claims directed to the following patentably distinct species: the different odorants of Claim 38. The species are independent or distinct because the claim-designated ingredients are characterized by divergently different chemical constituents. Thus, if Applicant elects any of groups VII set forth above, Applicant is **also** required under 35 U.S.C. 121 to elect a **single** disclosed species of odorant, **specifically stating the formula of said the one composition**, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1-11, 26, 34-37, 39 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MICHELE FLOOD
PRIMARY EXAMINER

Michele C. Flood

MCF
August 7, 2006

Michele Flood
Primary Examiner
Art Unit 1655